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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91210103
Party	Plaintiff The Coca-Cola Company
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In re: Application No. 85/672,347
Mark: COKI COLA HAPPY MOTION
Filed: July 10, 2012
Published: December 18, 2012

THE COCA-COLA COMPANY

Opposer,

v.

MIRIAM SOLER

and

ALBERTO SOLER, DBA COKI LOCO

Applicants.

Opposition No. 91210103

**MEMORANDUM OF OPPOSER THE COCA-COLA COMPANY IN OPPOSITION TO
APPLICANT'S MOTION TO DISMISS**

Opposer The Coca-Cola Company ("TCCC" or "Opposer"), by and through its undersigned counsel and in accordance with Rule 2.127 of the Trademark Rules of Practice, files this memorandum in opposition to the Motion to Dismiss filed by Alberto Soler on behalf of Applicants on April 22, 2013 ("Applicants' Motion").

MOTION WAS IMPROPERLY FILED AND NOT SERVED

As a preliminary matter, Applicant asserts in its motion and attached certificate of service that the motion was filed on April 22, 2013 and served by e-mail and first class mail to Opposer's representative. As of May 15, 2013, Opposer has not received any service from Applicant by first class mail. Furthermore, Opposer did not receive notice

nor a copy of the motion by email, nor has Opposer consented to service by email. Opposer only learned of Applicant's motion to consolidate through Opposer's a routine check of the proceedings online.

Accordingly, Opposer requests leave to file this response at this time, as the tolling for the deadline to respond has not officially begun due to the failure of Applicant to complete proper service of the motion.

ARGUMENT AND CITATION OF AUTHORITIES

Applicants' Motion is meritless and appears to have been filed solely with the purpose of delaying these proceedings, to harass Opposer, and to escalate costs associated with this proceeding, in contravention of 37 C.F.R. §11.18 and other applicable rules of practice. A motion to dismiss for failure to state a claim upon which relief can be granted examines the legal sufficiency of a complaint. *Advanced Cardiovascular Systems Inc. v. SciMed Life Systems Inc.*, 988 F. 2d 1157, 26 U.S.P.Q.2d 1038, 1041 (Fed. Cir. 1993). When evaluating a motion to dismiss under Fed. R. Civ. P. 12(b)(6), a court must accept the facts in the complaint as true and give the complaint every possible favorable inference. *Id.* To survive a motion to dismiss, a complaint must "state a claim to relief that is plausible on its face." *Bell Atlantic Corp. v. Twombly*, 550 U.S. 554, 570 (2007). In the context of an opposition proceeding, the complaint need only allege such facts as would, if proved, establish that the plaintiff is entitled to the relief sought, that is, that (1) the opposer has standing to maintain the proceeding, and (2) a valid ground exists for denying the registration sought. *Young v. AGB Corp.*, 152 F.3d 1377, 47 U.S.P.Q.2d 1752, 1754 (Fed. Cir. 1998).

In Applicants' Motion, no issue is raised with regard to Opposer's standing or specifically with regard to any failure to establish a valid ground for denying the registration sought. Instead, Applicants claim that Opposer must "plead acquired distinctiveness, stronger distinctiveness for dilution," and Applicants further claim that "knowing filing the application under a false owner's name can never constitute fraud because the misrepresentation defeats registration." See Applicants' Motion at 1. Applicants claim that Opposer's "grounds (1) thru (3) should be dismissed unless TCCC amends its opposition by establishing they have acquired/strong distinctiveness." *Id.* at 2. "Grounds (1) thru (3)" refer to Opposer's claims of ownership of prior registrations, likelihood of confusion, and dilution, none of which require a showing of acquired distinctiveness. Applicants' motion has no merit.

OWNERSHIP OF PRIOR REGISTRATIONS

In order for Opposer to establish a claim of priority, it must allege facts showing proprietary rights in its pleaded mark that are prior to the defendant's rights in the challenged mark. Such rights may be shown by, for example, ownership of a registration with an underlying application filing date prior to any date of first use on which defendant can rely, or by prior trademark or service mark use. See TBMP 309.03(c)(A).

Opposer has provided a list of several federal registrations for its COCA-COLA and COKE family of marks. See Notice of Opposition at 1. Opposer asserts its continuous and longstanding use of its trademarks. *Id.* Opposer further asserts that such use is prior to use by Applicant, which, upon information and belief, has not commenced. *Id.*, at 6.

There is simply no requirement under this ground that Opposer claim acquired distinctiveness. Opposer has satisfied the requirements of asserting priority as a basis for opposition against registration of COKI COLA HAPPY MOTION by Applicants, and therefore Applicants' Motion must be denied with regard to this ground.

LIKELIHOOD OF CONFUSION

In order to establish a claim of likelihood of confusion, Opposer must claim ownership of a proprietary right in the marks being asserted, priority over the Applicants, and that the Applicants' proposed mark is confusingly similar in appearance, sound, and meaning to the Opposer's marks and will be used in connection with substantially similar goods. See Lanham Act, Section 2(d). Again, contrary to Applicants' Motion, Opposer is not required to show acquired distinctiveness to establish this claim.

Opposer's proprietary right in its COCA-COLA and COKE family of marks is not in question. These marks are registered on the Principal Register, and many of them are incontestable, thus, they are presumed to be valid. As established above, Opposer's priority of rights over the Applicants' filing of the application is clear, and Applicants have not alleged any use of COKI COLA HAPPY MOTION. Finally, Opposer has established a claim that Applicants' proposed COKI COLA HAPPY MOTION mark is similar in sight, sound, and meaning to Opposer's COCA-COLA family of marks, and that the goods and services provided under the respective marks are substantially identical. See Notice of Opposition at 6-7. Accordingly, Opposer has established a claim of likelihood of confusion.

In their motion, Applicants rely on *Otto Roth* and *Towers*, which involve unregistered trademarks, and *U.S. v. Forty Barrels*, which is a 1916 case involving the

Food and Drug Act with no discussion of trademark law, to somehow support a claim that Opposer's COCA-COLA mark is "losing its robe for becoming part generic after swearing not true not to be dethroned." Applicants' Motion at 2. Applicants' intention with this statement is unclear, but regardless, Opposer has established its claim through the use of its long-registered marks, which are incontestable on the issue of descriptiveness. *Park 'N Fly, Inc. v. Dollar Park & Fly, Inc.*, 469 U.S. 189, 196 (1985). As noted in *Dixi-Cola*, cited by Applicants, "It is certainly beyond dispute that the word 'Coca-Cola' is the exclusive property of the Coca-Cola Company." 117 F.2d 352, at 354 (4th Cir. 1941).

DILUTION

Applicants further state that "Under dilution, there must be a 'stronger' showing of acquired distinctiveness." Applicants' Motion at 2. In reality, a claim of dilution requires demonstration of (a) ownership of a famous trademark, (b) that Opposer's mark became famous prior to the date of the application to register the Applicant's mark, and (c) that Applicant's mark is likely to cause dilution by blurring the distinctiveness of Opposer's famous mark, or by tarnishing the reputation of Opposer's famous mark. See *Research in Motion Limited v. Defining Presence Marketing Group Inc.*, 102 U.S.P.Q.2d 1187 (TTAB 2012); *Coach Services, Inc. v. Triumph Learning LLC*, 96 U.S.P.Q.2d 1479 (TTAB 2010) (non-precedential), *aff'd-in-part, rev'd-in-part and remanded on other grounds* (citation omitted).

With regard to ownership of a famous trademark, Opposer has alleged and pleaded facts sufficient to satisfy this requirement, as its COCA-COLA Marks are famous. See Notice of Opposition at 7-8. Furthermore, the COCA-COLA Marks, which

include “the top two soft drink brands in the world,” became famous prior to the date of Applicants’ attempt to register COKI COLA HAPPY MOTION through the subject application, filed on July 10, 2012. *Id.*

Finally, Opposer has alleged and pleaded facts sufficient to establish dilution both by blurring and by tarnishment in this matter. Dilution by blurring occurs when “the similarity between a mark or trade name and a famous mark...impairs the distinctiveness of the famous mark.” 15 U.S.C. §1125(c)(2)(B). Opposer alleged such harm in paragraph 12 of the Notice of Opposition, and facts that support the allegation in paragraphs 1-5 and 9-11. Dilution by tarnishment occurs when “the similarity between a mark or trade name and a famous mark...harms the reputation of the famous mark.” 15 U.S.C. §1125(c)(2)(C). Opposer alleged facts that would establish reputational damage in paragraphs 1-5 and 9-11.

FRAUD

With regard to Opposer's claim that Applicants committed fraud in their attempt to register COKI COLA HAPPY MOTION, Applicants admit that “Misrepresentation on the true owner of the application defeats registration,” and then they curiously present three alternative scenarios to explain the misrepresentation on their application. Applicants’ Motion at 3. Furthermore, Applicants have recently filed a Motion to Consolidate which acknowledges the act of fraud alleged by Opposer, namely, that Applicants have filed other trademark applications for marks intended to be confusingly similar to Opposer’s marks using different applicant names. Regardless of whether the filing was done, as Applicants suggest, “to deceive another not the USPTO,” Applicants do not deny that they submitted untrue or misleading information on their applications,

but instead they appear to believe that misrepresentation is acceptable if it is intended to deceive someone other than the USPTO. Alternatively, they state that the misinformation may have been a clerical error, or that there may have been no misinformation, but they have failed to refute Opposer's claim through presenting alternate scenarios, one of which would admit intentional fraud.

Therefore, Opposer has alleged that Applicants made (1) a false representation or withholding of information; (2) regarding a material fact; and (3) that Applicant knew or should have known that it was false or misleading has only been confirmed by the Applicants own statements, and this basis for the opposition has also been established. See *J.E.M. Int'l Inc. v. Happy Rompers Creations Corp.*, 74 U.S.P.Q.2d (BNA) 1526, 1529 (T.T.A.B. 2005).

LACK OF BONA FIDE INTENT TO USE

Applicants' Motion does not refute that Opposer established a claim for lack of bona fide intent to use in its opposition. Rather, Applicants state confusingly that "Further and to assist those minds in need. TCCC does not need to plead bad faith/fraud on ground (5) lack of bona fide intent to use." Applicants' Motion at 4. Opposer confirms that it has alleged facts sufficient to establish this claim as well, given the filing by Applicants and their related entities or aliases of a family of applications for marks which are intended to imitate Opposer's famous COCA-COLA marks. The misidentification of the true owners of the present application and, upon information and belief, at least six other applications, should be sufficient to establish that the alleged owners of these applications do not have a real and legitimate stake in acquiring a registration for this mark.

CONCLUSION

Applicants' Motion to Dismiss makes no substantiated arguments and does not allege that the Opposer has not sufficiently established any of the five grounds outlined in the Notice of Opposition. On the contrary, Opposer has confirmed herein that each of the grounds of the Notice of Opposition is fully supported and legally sufficient. Furthermore, through their Motion to Consolidate, Applicants appear to have acknowledged the actions of fraudulent misrepresentation alleged in the Notice of Opposition.

For the foregoing reasons, Opposer respectfully requests that Applicants' Motion to Dismiss be denied and that Applicants be required to answer the Notice of Opposition as filed.

Respectfully submitted, this 16th day of May, 2013.

PARKS IP LAW LLC

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CERTIFICATE OF SERVICE

This is to certify, in accordance with Rule 2.101(b) of the Trademark Rules of Practice, that I have this day served the foregoing Opposition of the Applicants, by causing a true and correct copy thereof to be deposited in the United States Mail, postage prepaid, addressed to the attorney of record for the Applicants as follows:

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This 16th day of May, 2013.

/s/ Cynthia R. Parks

Cynthia R. Parks